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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,786	01/07/2002	Hardayal Singh Gill	IBM1P006/SJ0920010087US1	3113

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EXAMINER

KLIMOWICZ, WILLIAM JOSEPH

ART UNIT PAPER NUMBER

2652

DATE MAILED: 07/19/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/041,786

Applicant(s)

GILL ET AL.

Examiner

William J. Klimowicz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on June 21, 2004 (Amendment C; Paper No. 10) has been entered.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regard to amended claim 1, the newly added limitations "wherein a thickness of a majority of each of the shields is less than one half a width of the associated shield, the widths of the shields being measured in a direction parallel to the plane in which the EMR sensor resides,

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the thicknesses of the shields being measured in a direction perpendicular to the widths thereof” has no support as provided in the disclosure, as originally filed by the Applicants.

The instant disclosure is completely silent with regard to the drawings being a “scaled version” of the actual product, particularly between and among different Figures of drawings. It is noted that typically, the actual MR sensors and their associated shields are on the order of millionths and/or billionths of a meter. The Figures represented by the Applicants’ drawings are certainly not to scale, and there is absolutely no relationship that the drawings of the individual elements within a particular Figure are to scale relative to other elements within the Figures.

Typically, in thin film MR applications, one particular component of a Figure is greatly exaggerated in size relative to another element or component within the same Figure, in order to emphasize its importance. Since the instant applications is completely silent in this regard, and does not in anyway imply or infer that the components of the Figures are individually, or alternatively, collectively drawn to a particular scale, the addition of the language to the independent claims are seen to constitute NEW MATTER.

Similarly, with regard to independent claim 16, the newly added limitation “wherein one of the shields has a centerline, where at least about 75% of the centerline resides along intersecting planes, one plane being parallel to a flow of flux through the shields, the other plane being perpendicular thereto;” claim 17, the phrase “wherein a thickness of a majority of each of the shields is less than one half a width of the associated shield, the widths of the shields being measured in a direction parallel to the plane in which the EMR sensor resides, the thicknesses of the shields being measured in a direction perpendicular to the widths thereof;” claim 18, the phrase, “wherein a thickness of a majority of each of the shields is less than one half a width of

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the associated shield, the widths of the shields being measured in a direction parallel to the plane in which the MR sensor resides, the thicknesses of the shields being measured in a direction perpendicular to the widths thereof;" claim 19, the phrase "wherein a thickness of a majority of each of the shields is less than one half a width of the associated shield, the widths of the shields being measured in a direction parallel to the plane in which the EMR sensor resides, the thicknesses of the shields being measured in a direction perpendicular to the widths thereof;" claim 20, the phrase "wherein a thickness of a majority of each of the shields is less than one half a width of the associated shield, the widths of the shields being measured in a direction parallel to the plane in which the EMR sensor resides, the thicknesses of the shields being measured in a direction perpendicular to the widths thereof;" and claim 21, the phrase "wherein a thickness of a majority of each of the shields is less than one half a width of the associated shield, the widths of the shields being measured in a direction parallel to the plane in which the 1?MR sensor resides, the thicknesses of the shields being measured in a direction perpendicular to the widths thereof, wherein one of the shields has a centerline, where at least about 75% of the centerline resides along intersecting planes, one plane being parallel to a flow of flux through the shields, the other plane being perpendicular thereto wherein the gap is offset from a center plane extending long, a center line of the EMR sensor, the center line and center plane being parallel to the plane in which the EMR sensor is positioned" each set forth particular relationships among constituent parts as undisclosed relatively sized relationships, which have no support in the original disclosure inclusive of the unscaled drawings, for the reasons articulated, *supra*.

Moreover, as set forth in MPEP, section 2125:

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**PROPORTIONS OF FEATURES IN A DRAWING ARE NOT EVIDENCE OF ACTUAL PROPORTIONS WHEN DRAWINGS ARE NOT TO SCALE**

When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int 'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. "[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue."). However, the description of the article pictured can be relied on, in combination with the drawings, for what they would reasonably teach one of ordinary skill in the art. *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977) ("We disagree with the Solicitor's conclusion, reached by a comparison of the relative dimensions of appellant's and Bauer's drawing figures, that Bauer clearly points to the use of a chime length of roughly 1/2 to 1 inch for a whiskey barrel.' This ignores the fact that Bauer does not disclose that his drawings are to scale. ... However, we agree with the Solicitor that Bauer's teaching that whiskey losses are influenced by the distance the liquor needs to traverse the pores of the wood' (albeit in reference to the thickness of the barrelhead)" would have suggested the desirability of an increased chime length to one of ordinary skill in the art bent on further reducing whiskey losses." 569 F.2d at 1127, 193 USPQ at 335-36.)

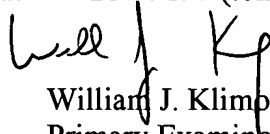
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (703) 305-3452. The examiner can normally be reached on Monday-Thursday (6:30AM-5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
William J. Klimowicz  
Primary Examiner  
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WJK